

REMARKS

Summary of Office Action

Claims 1, 3-10, 12, 13, 15-19, 21, and 24-37 were pending in this application.

Claims 1, 3-7, 12, 13, 15-19, 21, 28-30, and 35-37 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Ellis et al. U.S. Patent Publication No. 2003/0204847 (Ellis") in view of Zigmond et al. U.S. Patent No. 6,698,020 ("Zigmond").

Claims 8 and 9 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Ellis and Zigmond in view of Alten et al. U.S. Patent No. 5,635,978 ("Alten").

Claim 10 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Ellis, Zigmond, and Alten in view of and Marshall et al. U.S. Patent No. 5,828,420 ("Marshall").

Claims 25 and 32 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Ellis and Zigmond in view of Macrae et al U.S. Patent Publication No. 2003/0208756 ("Macrae").

Claims 26, 27, 33, and 34 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Ellis and Zigmond in view of Schein et al. U.S. Patent Publication No. 2003/0208758 ("Schein").

The Examiner's rejections are respectfully traversed.

Applicant's Reply

The Examiner rejected applicant's independent claims 1 and 13 as being unpatentable over Ellis in view of Zigmond. Applicant respectfully traverses this rejection.

Applicant's independent claims 1 and 13 are directed toward a television system and method in which a

television program is displayed on a substantially full portion of a display monitor and a pop up window is overlaid on the displayed television program, simultaneously displaying the television program with both an informational message and an advertising message. The informational message is selected from a television program schedule database containing television program schedule information, informational messages, and information links that link the informational messages to the television program schedule information. The advertising message that is linked to the displayed television program is selected from an advertising database containing advertising messages and advertisement links that link the advertising messages to the television program schedule information.

The Examiner asserts that Ellis teaches all of the features of applicant's independent claims, except for selecting the advertising from the advertising database to be displayed in the pop up window overlaid on the displayed television program. The Examiner attempts to remedy this deficiency by combining Ellis with Zigmond.

Applicant respectfully submits that, as set forth in detail below, the §103 rejection is insufficient as a matter of law. In particular, the Examiner has failed to provide motivation to combine the references and has employed hindsight reconstruction in combining the references.

I. THE EXAMINER HAS FAILED TO PROVIDE
MOTIVATION TO COMBINE THE REFERENCES

In order to establish a prima facie case of obviousness based on a combination of references, there must be "some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves

or in the knowledge generally available to one of ordinary skill in the art." MPEP, at § 2143.01. Applicant respectfully submits that the Examiner has failed to fulfill the requirement of presenting an "objective teaching . . . or . . . knowledge generally available to one of ordinary skill in the art that would lead that individual to combine the relevant teachings of the references," In re Fine, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). See In re Rouffet, 149 F.3d 1350, 1355 ("When a rejection depends on a combination of prior art references, there must be some teaching, suggestion, or motivation to combine the references"). "Broad conclusory statements regarding the teaching of multiple references, standing alone, are not 'evidence' of a motivation to combine. In re Dembiczak, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999), abrogated on other grounds by In re Gartside, 53 USPQ2d 1769 (Fed. Cir. 2000).

In support of the combination of Ellis with Zigmond, the Examiner states that:

[I]t would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Ellis et al. overlay including advertisements with Zigmond et al. ad database and ad links for the purpose of generating increased advertisement revenue for program providers and providing advertisements that are more likely to appeal to the user and thus increase advertising effectiveness for the advertisers. Office Action, page 3.

Applicant respectfully submits that increased revenue is not the "objective teaching" necessary to provide motivation to combine Ellis and Zigmond. Rather, the Examiner has merely listed an alleged benefit of applicant's novel invention as motivation to combine the references instead of pointing to an objective teaching in either Ellis

or Zigmond that would lead one of ordinary skill in the art to combine these references.

Namely, the Examiner has indicated that there is a benefit to displaying advertising messages in a pop up window overlaid on the displayed television program that are selected from an advertising database linked to a displayed television program, rather than, for example, selecting the advertising messages at random. However, the Examiner has not provided any indication why one of ordinary skill in the art would be motivated to combine Ellis's system and method for displaying a graphic overlay as part of an electronic program guide that may include advertisements with Zigmond's system and method for selecting and inserting video advertisements into a video programming feed.

These two references refer to two completely different and unrelated advertising techniques. Ellis refers to advertisements that are displayed as part of an electronic program guide system. The advertisements are displayed when a user initiates the BROWSE mode and are overlaid over the currently tuned television program such that the user may simultaneously view the advertisement and the television program. In contrast, Zigmond refers to conventional full screen video advertisements that are inserted in the midst of television broadcasts at appropriate times to display advertisements, thereby interrupting the video programming feed to provide the advertising message independent of any user interaction.

These unrelated references cannot be combined in the manner suggested by the Examiner without an objective teaching in either Ellis or Zigmond that would lead one of ordinary skill in the art to combine these references.

Application No. 09/555,551
Amendment dated May 17, 2006
Reply to February 17, 2006 Office Action
Accordingly, the Examiner has not provided sufficient
motivation to combine Ellis or Zigmond.

II. THE EXAMINER HAS EMPLOYED HINDSIGHT
RECONSTRUCTION IN COMBINING THE REFERENCES

Applicant respectfully submits that the Examiner has employed hindsight reconstruction in combining the references. With the knowledge of applicant's novel system for selecting the advertisements that are displayed to television viewers in a pop up overlay, particular features of the prior art were identified for use in rejecting applicant's invention. This technique has long been held invalid by the courts at creating a prima facie case of obviousness. See *In re Fine*, 5USPQ2d at 1600. ("One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.").

The Examiner has used applicant's own invention as a bridge between Ellis and Zigmond. In doing so, the Examiner has demonstrated mere hindsight reconstruction, the very "syndrome" that the requirement for objective evidence is designed to combat, and the rejection is therefore insufficient as a matter of law. See *In re Dembiczak*, 50USPQ2d at 1617-1618.

Conclusion

Accordingly, for at least these reasons, applicant respectfully requests that the rejection of amended independent claims 1 and 13 over Ellis in view of Zigmond under 35 U.S.C. § 103(a) be withdrawn.

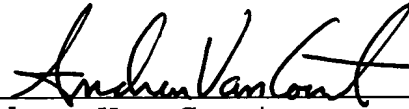
Applicant also respectfully requests that claims 3-10, 12, 15-19, 21, and 24-37 be allowed, at least

Application No. 09/555,551
Amendment dated May 17, 2006
Reply to February 17, 2006 Office Action

because they variously depend from allowable independent claims 1 and 13.

The foregoing demonstrates that claims 1, 3-10, 12, 13, 15-19, 21, and 24-37 are allowable. This application is therefore in condition for allowance. Reconsideration and allowance of this application are accordingly respectfully requested.

Respectfully submitted,



Andrew Van Court
Registration No. 48,506
Agent for Applicant
Fish & Neave IP Group
Ropes & Gray LLP
Customer No. 1473
1251 Avenue of the Americas
New York, New York 10020
Tel.: (212) 596-9000
Fax: (212) 596-9090